UNITED STATES PATENT AND TRADEMARK OFFICE

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FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
ALVESTEFFER, STEPHEN D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 October 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-27 and 29-56* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-27 and 29-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to the after-final amendment filed October 22,
2007. The finality of the Final Office Action dated August 21, 2007 is withdrawn
because 35 U.S.C. § 103(c) disqualifies the Heikes reference (2003/0225847 used in
rejection of claims 16-18 and 42-44) from being used as the basis for an obviousness
rejection under 35 U.S.C. § 103(a). Prosecution on the merits of the instant application
is re-opened.

Claims 22, 49-51, 54, and 56 are amended. Claims 1, 26, 27, and 52 are
independent. Claims 1, 3-27, and 29-56 remain pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 27 and 29-52 are rejected under 35 U.S.C. 101 because the claimed
invention is directed to non-statutory subject matter. Claims 27 and 29-52 recite a
computer program stored on a computer readable medium. The specification states
that the computer readable medium comprises a propagated signal (see specification
page 4, lines 2-4), which is non-statutory according to MPEP 2106. A propagated
signal does not fall under any of the statutory categories of invention provided by 35
U.S.C. 101 because it is not a new and useful process, machine, manufacture, or
composition of matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, 8-11, 19-21, 26, 27, 29-32, 34-37, 45-47, and 52-56 are rejected

under 35 U.S.C. 102(e) as being anticipated by Hashemi, United States Patent

Application Publication number 2003/0212804.

Regarding claim 1, Hashemi teaches a computer implemented method for

sending a video clip in an instant messaging communications session, the method

comprising: storing, on a host system, a collection of video clips available to be sent to

instant message recipients in instant messaging communications sessions (see

paragraph [0058]; "*the list of media clips may advantageously be exchanged through*

the central server 102, which can also be configured to store the list of media clips"; see

also paragraph [0067]; "*The media clips can be locally stored or retrieved from remote*

resources"); establishing an instant messaging communications session between an

instant message sender and an instant message recipient (see paragraph [0047]; "*One*

embodiment permits the users within a peer group to simultaneously chat while a media

clip may advantageously be streamed from one user in the peer group to other users in

the peer group"); providing the instant message sender with access to the collection of

video clips stored on the host system (see paragraph [0047]; "*The exemplary media clip*

browse window 204 displays a list of peers that may advantageously be signed in or

logged onto the central server 102 and displays the media clips from the peers that may

advantageously be available for streaming"); receiving, at the host system, a request

from the instant message sender for a particular video clip from among the collection of

video clips stored on the host system to be delivered to the instant message recipient

(see paragraph [0060]; "*In one embodiment, the streaming of a media clip may*

advantageously be sent to a peer group or subset of a peer group by a member of the

peer group that initiates streaming to the peer group of the subset"); in response to

receiving the request from the instant message sender for the particular video clip to be

delivered to the instant message recipient, sending a video clip identifier corresponding

to the particular video clip to the instant message recipient (see paragraph [0081]; "*The*

File Reference field 616 can contain information such as a filename and path for the

corresponding media clip on the user computer identified in the Peer Computer

Reference field 612", a media clip identifier inherently must be sent to the instant

message recipient); after sending the video clip identifier corresponding to the particular

video clip to the instant message recipient, receiving, from the instant message

recipient, a request for the particular video clip (see paragraph [0025]; "*A media clip*

selection module 136 permits a user to select which media clips from a list of media

clips may be received in a stream from another user computer"); in response to

receiving the request for the particular video clip, accessing the particular video clip

from the collection of video clips stored at the host system and communicating the

particular video clip from the host system to the instant message recipient for rendering

(see paragraph [0039]; *"Streaming of a media clip advantageously permits the computer*

receiving the stream to play or display the media clip while the media clip transfers and

before an entire file has been transferred").

Regarding claim 3, Hashemi teaches that receiving the request from the instant

message sender from the particular video clip to be delivered to the instant message

recipient comprises receiving a request that is generated in response to a

communication from the instant message sender to the instant message recipient (see

paragraph [0039]; *"In one embodiment, when a user computer communicates with*

another user computer to send a stream of a media clip").

Regarding claim 4, Hashemi teaches that receiving the request from the instant

message sender for the particular video clip to be delivered to the instant message

recipient comprises receiving the identifier corresponding to the particular video clip

(see paragraph [0081]; *"The File Reference field 616 can contain information such as a*

filename and path for the corresponding media clip on the user computer identified in

the Peer Computer Reference field 612", a media clip identifier inherently must be sent

to the instant message recipient).

Regarding claim 5, Hashemi teaches that receiving the identifier further

comprises receiving an identifier comprising a location on the host system of the

selected video clip (see paragraph [0081]; *"The File Reference field 616 can contain*

information such as a filename and path for the corresponding media clip on the user

computer identified in the Peer Computer Reference field 612", a media clip identifier
includes the location of the media clip on the host system).

Regarding claim 6, Hashemi teaches that the identifier further comprises a file
name (see paragraph [0081]; "*The File Reference field 616 can contain information
such as a filename and path for the corresponding media clip on the user computer
identified in the Peer Computer Reference field 612*", a media clip identifier includes the
filename of the media clip).

Regarding claim 8, Hashemi teaches that receiving the identifier comprises
receiving the identifier in response to a communication from the instant message sender
to the instant message recipient (see paragraph [0039]; "*In one embodiment, when a
user computer communicates with another user computer to send a stream of a media
clip*", the identifier inherently must be sent before the media clip can be accessed).

Regarding claim 9, Hashemi teaches that the host comprises a server
authorized as a partner to an instant messaging host (see paragraph [0058]; "*the list of
media clips may advantageously be exchanged through the central server 102, which
can also be configured to store the list of media clips*", Hashemi's invention utilizes
centralized peer-to-peer file sharing).

Regarding claim 10, Hashemi teaches that storing the video clips comprises
storing one or more still photographs and a sound track (see paragraph [0021]; "*A
media clip includes at least a portion of an audio work or a video work, which has been
recorded or stored*", a video clip is inherently the same as one or more still photographs
and a sound track).

Regarding claim 11, Hashemi teaches that storing the video clips comprises storing an animation sequence (see paragraph [0021]; *"A media clip includes at least a portion of an audio work or a video work, which has been recorded or stored"*, a video clip can reasonably be interpreted as being the same as an animation sequence).

Regarding claim 19, Hashemi teaches determining whether the particular video clip is an official item; and displaying the particular video clip if the video clip is an official item. The specification of the instant application is silent as to how to differentiate an "official item" from a regular item. Therefore, this dependent claim is not patentably distinct from its parent claim and does not recite any additional limitations.

Claims 20 and 21 recite significantly the same limitations as claim 1 and are therefore rejected under the same rationale.

Claim 26 recites a method with substantially the same limitations as the method of claim 1. Therefore, claim 26 is rejected under the same rationale.

Claims 27, 29-32, 34-37, and 45-47 recite a computer program with substantially the same limitations the method of claims 1, 3-6, 8-11, and 19-21, respectively. Therefore, the claims are rejected under the same rationale

Claim 52 recites a computer program with substantially the same limitations as the method of claim 26. Therefore, claim 52 is rejected under the same rationale.

Regarding claim 53, Hashemi teaches that providing the instant message sender with access to the collection of video clips stored on the host system comprises sending a list of the available video clips to the instant message sender (see paragraph

[0025]; "*A media clip selection module 136 permits a user to select which media clips from a list of media clips may be received in a stream from another user computer*").

Regarding claim 54, Hashemi teaches receiving, at the host system, a request from the instant message sender to preview the particular video clip from the collection of video clips stored on the host system; in response to receiving the request to preview the particular video clip, accessing the particular video clip from the collection of video clips stored on the host system and communicating the particular video clip from the host system to the instant message sender for previewing, wherein receiving the request from the instant message sender for the particular video clip to be delivered to the instant message recipient occurs after the particular video clip has been sent to the instant message sender for previewing. The invention as taught by Hashemi is capable of allowing the sender to view a video clip prior to sending it to another user via an instant message (chat) application (see paragraph [0066]; "*The selected media clips can further include media clips that may advantageously be locally accessible from the user's computer*"; see also paragraph [0047]; "*One embodiment permits the users within a peer group to simultaneously chat while a media clip may advantageously be streamed from one user in the peer group to other users in the peer group*").

Claims 55 and 56 recite substantially the same limitations as claims 53 and 54, respectively. Therefore, the claims are rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hashemi (2003/0212804) *supra* and Van Hoff et al. (hereinafter Van Hoff), United

States Patent number 5,919,247.

Regarding claim 7, Hashemi teaches all the limitations of claim 7 except that

receiving the identifier comprises receiving an identifier created for the selected video

clip based upon the application of an algorithm to at least a portion of the selected video

clip. Van Hoff teaches using a cryptographic hash algorithm such as Message-Digest

Algorithm 5 (MD5) to verify the identity of a file, which was a well known method to

persons of ordinary skill in the art at the time the invention was made (see Van Hoff

column 6 lines 14-21). It would have been obvious to one of ordinary skill in the art at

the time the invention was made to use the cryptographic hash algorithm method taught

by Van Hoff with the method of Hashemi in order to verify the identities of requested

video clips.

Claim 33 recites a computer program with substantially the same limitations as

the method of claim 7. Therefore, claim 33 is rejected under the same rationale.

Claims 12-15 and 38-41 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hashemi (2003/0212804) *supra* and Snyder et al. (hereinafter

Snyder), United States Patent number 6,070,171.

Regarding claims 12-15, Hashemi teaches all the limitations of claims 12-15

except that storing the video clips comprises storing one or more video clips configured

to expire upon the occurrence of a predetermined event; the predetermined event

comprises passage of a predetermined length of time or the passage of a

predetermined date; the predetermined event comprises a predetermined number of

uses; determining whether a video clip has expired, and disallowing access to the video

clip if the video clip has expired. However, Snyder teaches disallowing access to

software content after a predetermined duration or number of uses (see Snyder column

12 lines 44-49; "*Other examples of Software Payloads (SP) for use with the present

invention are on game disks and film on CDROMs whereby copying is prevented and/or

time of use is constrained. Also, rental software can use the invention to limit the

duration of use and/or the number of uses*"). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to likewise disallow access

(as taught by Snyder) to other media content such as video (as taught by Hashemi) for

the purpose of protecting the intellectual property rights of video.

Claims 38-41 recite a computer program with substantially the same limitations

as the method of claims 12-15. Therefore, the claims are rejected under the same

rationale.

Claims 16-18 and 42-44 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hashemi (2003/0212804) *supra* and Levi et al. (hereinafter Levi),

United States Patent Application Publication number 2003/0236835.

Regarding claims 16-18, Hashemi teaches all the limitations of claims 16-18

except determining whether a video clip has been banned, and disallowing access to

the video clip if the video clip has been banned; determining whether the video clip has

been banned comprises determining whether the video clip has been banned based on

a report by a user; and determining whether the video clip has been banned comprises

determining whether the video clip has been banned based on a violation of a term of a

service agreement. However, Levi teaches instant messaging software in which users

can report abuse by other users to ban them (see Levi paragraph [0052]; "*In addition,*

the profile option allows a user to report abuse to the administrative manager if the

sender of the video mail is forwarding threatening or otherwise inappropriate messages.

This abuse option allows users to effectively control specific abuse instances which are

directed at the user. In this manner, the abusive user need not be globally banned, but

can be restricted via the administrative manager (discussed below) with respect to this

particular user"). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to impose the same methods for reporting abuse and

banning users as taught by Levi on the media clips of Hashemi for the purpose of

enforcing a service agreement for the use of the media clips.

Claims 42-44 recite a computer program with substantially the same limitations as the method of claims 16-18. Therefore, the claims are rejected under the same rationale.

Claims 22-25 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashemi (2003/0212804) *supra*, and Video: An empirical study of realvideo performance across the internet, from Proceedings of the 1st ACM SIGCOMM Workshop on Internet Measurement IMW '01, by Yubing Wang, Mark Claypool, and Zheng Zuo (hereinafter Wang).

Regarding claims 22-25, Hashemi teaches all the limitations of claims 22-25 except for determining capabilities of the instant messaging participant at the host system by determining a data connection speed, identifying hardware associated with the instant messaging participant system, and identifying software associated with the instant messaging participant system, then determining an appropriate version from one or more versions of the selected video clip based upon the determined capabilities and accessing the appropriate version of the selected video clip. Wang teaches determining capabilities of the instant messaging participant at the host system by determining a data connection speed, identifying hardware associated with the instant messaging participant system, and identifying software associated with the instant messaging participant system (see page 298 paragraph 2), then determining an appropriate version from one or more versions of the selected video clip based upon the determined capabilities and accessing the appropriate version of the selected video clip (see page

297, Bandwidth Characteristics section). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to combine the methods taught by

Wang with the invention taught by Hashemi in order to provide video clips that are

appropriate for each user's system.

Claims 48-51 recite a computer program with significantly the same limitations

as claims 22-25. Therefore, they are rejected under the same rationale.

Response to Arguments

Claims 22, 49-51, 54, and 56 have been amended to correct informalities.

Accordingly, all objections to the claims are withdrawn.

Applicant's arguments, see Amendment in Reply to Action, filed October 22,

2007, with respect to 35 USC § 101 rejections have been fully considered and are

persuasive. The 35 USC § 101 rejections of claims 27, 29-52, 55, and 56 have been

withdrawn.

Applicant asserts that Hashemi fails to describe or suggest storing, on a host

system, a collection of video clips available to be sent to instant message recipients in

instant messaging communications sessions, and communicating a particular video clip

from the host system to an instant message recipient for rendering. The examiner

respectfully disagrees.

Applicant is interpreting the "host system" to be only the "central server". The

"central server" of Hashemi acts as a directory for locating video clips. However, once a

user has located a video clip and selected it for download, the medium in which it is

stored acts as the "host system" (see paragraph [0067]; "*The media clips can be locally*

stored or retrieved from remote resources").

Applicant asserts that Hashemi fails to describe or suggest receiving, at a host

system, a request from an instant message sender for a particular video clip from

among the collection of video clips stored on the host system to be delivered to an

instant message recipient. The examiner respectfully disagrees.

Hashemi does teach in one embodiment that a sender may initiate delivery of a

video clip directly to a recipient (see paragraph [0060]; "*In one embodiment, the*

streaming of a media clip may advantageously be sent to a peer group or subset of a

peer group by a member of the peer group that initiates streaming to the peer group of

the subset").

Applicant asserts that Hashemi does not describe or suggest receiving an instant

message that includes a video clip identifier corresponding to a selected video clip to be

displayed by the instant messaging recipient system. The examiner respectfully

disagrees.

Examiner maintains that an identifier of a video clip must inherently be sent to the

video clip recipient. If no identifier of the video clip is received by a recipient, the

recipient system would have no way of determining which video clip from the host system is to be shown.

Applicant asserts that Heikes reference (2003/0225847) should be disqualified from use as prior art as the basis for an obviousness rejection. The examiner agrees. As stated above, the finality of the Final Office Action dated August 21, 2007 is withdrawn because 35 U.S.C. § 103(c) disqualifies the Heikes reference (2003/0225847 used in rejection of claims 16-18 and 42-44) from being used as the basis for an obviousness rejection under 35 U.S.C. § 103(a).

Applicants assert that the term "tangible computer readable medium" is to be construed to include all forms of tangible computer readable media. Instant application specification page 4 lines 1-10 defines a computer readable medium as comprising "a disc, a client device, a host device, and/or a propagated signal". No definition of a **"tangible** computer readable medium" is given. Therefore, even with the word "tangible" added to the claims, the computer readable medium of the instant application is non-statutory. Applicant is reminded that a propagated signal does not fall under any of the statutory categories of invention provided by 35 U.S.C. 101 because it is not a new and useful process, machine, manufacture, or composition of matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Stephen Alvesteffer whose telephone number is (571)

270-1295. The examiner can normally be reached on Monday-Friday 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Stephen Alvesteffer
Examiner
Art Unit 2173

11-9-2007

TADESSE HAILU
PRIMARY EXAM